



Docket No. 420-002

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :
CHRISTOPHER S. NOLAN : Examiner Fox
Serial No.: 09/684,032 : Group Art Unit 3652
Filed: October 6, 2000 :
For: **LINER FOR CONTAINER** :
WITH SIDE DOOR :

REQUEST FOR RECONSIDERATION UNDER
37 C.F.R. §§ 1.143 AND 1.145

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant carefully reviewed the final Office Action mailed June 16, 2004, and respectfully requests reconsideration of the Examiner's decision to withdraw claims 12, 14, 16, and 18-20 from consideration pursuant to 37 C.F.R. Section 1.145.

The primary basis for this request is the lack of any support for the allegation that claims 12, 14, 16, and 18-20 are each "directed to an invention that is independent or distinct from the invention originally claimed." As observed in the Manual of Patent Examining Procedure (MPEP), "[t]here are two criteria for restriction between patentably distinct inventions: (A) The inventions must be independent . . . or distinct . . . ; and (B) There must be a serious burden on the examiner if restriction is required." MPEP § 803.01 (8th ed. May

2004). In addition to reciting in detail the standards to be applied in assessing whether restriction is warranted, the MPEP counsels that “Examiners must provide reasons and/or cite examples to support conclusions . . .” reached regarding restriction. *Id.* The requirement for a proper showing remains intact even when claims are added to an application already under examination. Specifically, Section 1.145 of the Code of Federal Regulations provides that:

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

37 C.F.R. § 1.145; *see also In re Kase*, 71 USPQ2d 1063 (Com'r of Patents 2004) (unpublished) (on Petition to the Commissioner of Patents, holding an Examiner’s withdrawal of newly presented claims improper because “[n]o reasons are given to show why the newly presented claims are independent and/or distinct . . .”).

Here, the Examiner’s restriction and withdrawal of claims 12, 14, 16, and 18-20 is premised on the allegation that “the state of the liner art has two well known species of liners, free standing pneumatically deployed liners and those that are manually deployed.” This unsupported contention does not provide a proper basis for the conclusion that the newly presented claims cover an invention “independent and/or distinct” from the invention previously claimed, which requires the application of multi-part criteria and citation to

reasons or examples supporting the conclusions reached. *See* MPEP §808 (8th ed. May 2004) (“Every requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween . . .”). Simply pointing out the differences in the inventions being claimed is inadequate. Moreover, the assertion that Applicant “constructively elected” the invention previously claimed does not and cannot serve as a substitute for the requisite showing of an independent and distinct invention using the longstanding tests enumerated in the MPEP. Indeed, if an Applicant is considered to have “constructively elected” examination of original or previously presented claims each time new claims are presented, this would render meaningless the requirement of Section 1.145 for a showing that the invention is independent and distinct before restricting newly presented claims.

Additionally, it has not been adequately shown that examining any of claims 12, 14, 16, and 18-20 creates a “serious” burden on the Examiner. Liners for containers with side doors, whether erected using air, manually deployed, or free-standing, do not require separate classification or a separate field of search. MPEP §808.02(A) and §808.02(C) (8th ed. May 2004). The Examiner cites no patents indicating separate status in the art or the need for a different field of search. MPEP §808.02(B) (8th ed. May 2004). Furthermore, Section 803.01 of the MPEP explains that “[i]f the search and examination of an entire application

can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to independent or distinct inventions.*"

In light of the foregoing, Applicant respectfully requests reconsideration of the decision to withdraw claims 12, 14, 16, and 18-20 from consideration.

Respectfully submitted,

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